

REMARKS

Claims 46-50, 52-54, 56-66, 68-80, and 106-113 are pending and at issue.

The office action confirms that claims 46-50, 52-54, 56-66, and 68-80, 106 and 113-118 recite allowable subject matter.

The office action rejects claims 46-50, 52-54, 56-66, and 68-118 under 35 U.S.C. § 251, as being broader than the claims of RE 37,585 F1.

The office action rejects claims 81-105 based on the grounds of non-statutory obviousness-type double patenting, based on claim 46 in copending U.S. Application Serial No. 09/775,069 in view of Stern et al., "Corneal Ablation by Nanosecond, Picosecond, and Femtosecond Lasers at 532 nm and 625 nm" and U.S. Patent No. 5,984,916, to Lai.

The office action rejects claims 81-105 under 35 U.S.C. § 103(a) as unpatentable over Stern et al., "Corneal Ablation by Nanosecond, Picosecond, and Femtosecond Lasers at 532 nm and 625 nm" in view of U.S. Patent No. 5,984,916, to Lai.

The office action has not rejected claims 107-113 on prior art grounds. Therefore, these claims are treated as confirmed as reciting allowable subject matter, for the purposes of this response.

Applicant respectfully traverses each of the rejections and requests their removal.

I. Status of Claims

Claims 46-50, 52-54, 56-66, 68-80, and 106-113 remain pending and at issue.

The status of the claims is as follows:

Cancelled: Claims 1-45, 51, 55, and 67;

Currently added: Claims 81-105 and 114-118;

Amended: Claims 58, 60, 63, 64, 68-71, 73, 74, 75, 84, and 106-113;

Twice Amended: Claims 53, 54, 57, 59, 61, 62, 65, 66, and 72;

Thrice Amended: Claims 50, 52, and 81;

Four Times Amended: Claims 46, 47, 48, 49, 56, 76, and 77;

Application No. 09/775,106
Amendment dated July 13, 2012
Non-Final Office Action of January 13, 2012

Docket No.: 30275/939A

Five Times Amended: Claims 79 and 80; and

Previously Added: Claims 82 and 83.

II. Reissue Oath/Declaration

Applicant will provide a supplemental reissue oath/declaration upon confirmation of the allowability of the pending claims.

III. Non-Statutory Obviousness-Type Double Patenting Rejection

Claims 81-105 were provisionally rejected on the grounds of non-statutory obviousness type double patenting. Applicant has canceled claims 81-105, without prejudice and only to expedite allowance. The rejections are traversed.

IV. Rejections under 35 U.S.C. § 103

The office action rejects claims 81-105 under 35 U.S.C. § 103(a) as unpatentable over Stern et al., “Corneal Ablation by Nanosecond, Picosecond, and Femtosecond Lasers at 532 nm and 625 nm” in view of U.S. Patent No. 5,984,916, to Lai.

Applicant has canceled claims 85-101, as well as claims 114-118 which depended from various of these claims. The rejection is therefore traversed.

No prior art rejections remain.

V. Discussion of Effect of RE37,585 F1, including MPEP § 1449.01, Estoppel, and 35 U.S.C. § 251 Rejections

The Examiner raises a number of objections/rejections based on Reexamination Certificate RE37,585 F1. It is not lost on the Applicant that this reexamination certificate issued four years ago; nor is it lost on the Applicant that this case had been ostensibly allowed back in the June 10, 2009 Official Action, when the Examiner confirmed allowability of the claims, leaving only the reissue declaration to be completed. Now, years later, and with no word from the patent office for nearly two years, the Examiner raises for first time objections and rejections based on MPEP § 1449.01(B) and its suggested guidelines for handling concurrent reexamination/reissue applications.

As detailed below, MPEP § 1449.01(B) did not exist at the time of the reexamination application and therefore does not dictate over the present application, either as a matter of

procedure or as a matter of fairness. Moreover, MPEP § 1449.01 would not have applied to the instant application, even if it were promulgated at the time, because there was not concurrence between the reexamination application and the reissue application, as concurrence has been defined under this section. Moreover still, MPEP § 1449.01 does not apply where the claims of the reissue application could not have been added to the reexamination case, as is the case with the instant application.

For these reasons, the rejections based on 35 U.S.C. § 251 of the Official Action are respectfully, but strongly traversed.

A. MPEP 1449.01(B) Did Not Exist at During the Pendency of the RE37,585 F1 Reexamination. MPEP 1449.01(B)(3) Does Not Apply.

As a threshold matter, Applicant respectfully asserts that MPEP § 1449.01(B), which serves as the basis for the § 251 rejections did, not exist during the pendency of the reexamination Application Serial No. 90/007,102 (hereinafter “the ‘102 Reexamination”) and therefore cannot be said to govern the instant application.

From the time the ‘102 Reexamination request was filed, when MPEP Eighth Edition, Rev. 2 (May 2004) governed, to the grant of the RE37,585 F1 Reexamination Certificate, when Rev. 5 (August 2006) governed, at no point was the language of MPEP § 1449.01(B) present. It was not until a year *after* the RE37,585 F1 Reexamination Certificate, i.e., MPEP Eighth Edition, Rev. 7 (July 2008), when MPEP § 1449.01 was amended to include the now-cited section entitled “Reexamination Certificate Is To Be Issued for a Patent, While a Reissue Application for the Patent Is Pending.”

Therefore, during the period of purported concurrence, neither the Applicant nor the Patent Office were privy to the guidelines of MPEP §1449.01(B), because such guidelines did not exist. That alone contravenes the current rejections as improper.

MPEP § 1449.01(B) sets forth actions that are to be taken by both applicants and the patent office when a reexamination certificate issues while a reissue application is pending. **MPEP § 1449.01 provided none of those instructions during the timeframe of the ‘102 Reexamination.** As a result, Applicant could not have known of the Examiner’s now-argued estoppel rationale, because such a rationale had no basis at the time – it did not exist.

The language in MPEP § 1449.01 at the time discussed merging reexamination applications and copending reissue applications or affirmatively staying one for the other. But nowhere did the MPEP provide guidelines (compare with the language of current subsection (B)) creating an estoppel for reissue applications that were neither merged nor stayed during the reexamination. To read into MPEP § 1449.01 such language when it did not exist has no basis in law. Nor is there any justification for applying subsection (B) retroactively, especially given the estoppel effect purportedly created therein. Fairness certainly dictates that Applicant should not be bound by guidelines there were not in place, until a year after the RE37,585 F1 Reexamination Certificate issued.

For these reasons, the objections/rejections under Paras. 5-7 of the Official Action are respectfully, but strongly traversed.

In the copending U.S. Application Serial No. 09/775,069, the Examiner recognizes that the language did not exist at the time of the previous prosecutions, but then states that the change in the MPEP did not result from a change in the law or rules but was merely a change in PTO policy. Applicant respectfully asserts that there is no basis in the law or rules for holding an applicant accountable for patent office procedures that did not at the time exist. Absent the gift of precognition, no applicant could know what untold future policy changes might occur and how those might affect them. The Examiner has pointed to the policy change as not stemming from a change in law or rule, but the Examiner has pointed to no law or rule that creates the estoppel suggested. None exists. The only basis for the estoppel is the patent office policy, which changed after the fact. Furthermore, that policy sets forth, as discussed below, particular procedures that the patent office is to follow, but that were not followed in the instant case. The applicant was provided no guidance, from the MPEP or the examiner, in regards to any policy change of note. And indeed, to the contrary, the examiner's actions were in line with the policy at the time of prosecution.

Therefore, applicant respectfully re-asserts that the rejections must fail as a matter of inapplicability, as being non-existent at the relevant time frame.

Moreover, as the Applicant notes in Sections B and C below, the policy simply does not apply to the present case, meaning that the change promulgated by the patent office would not apply to the instant case, even if it did exist. The Examiner is asked to

specifically address Sections B & C below if the rejection is to be maintained; the rejection should be removed.

- B. MPEP § 1449.01 Would Not Have Applied to the Instant Application Because the Reexamination Was Not Concurrent with the Subject Reissue Application, which had issued 2 years prior.

MPEP § 1449.01 pertains to situations in which a reexamination and concurrent reissue application are pending **at the same time for the same patent**, which is not the case here. Concurrence under MPEP § 1449.01 (then and now) pertains to the situation where a reissue application is pending at the same time a reexamination has been filed on the same patent, that is, on the **same** claims under reissue. MPEP § 1449.01 begins by citing 37 C.F.R. § 1.565(d), which discusses the ability to merge a pending reissue application and a co-pending reexamination. Merger stems from a desire for administrative economy, to prevent claims that are in the process of being corrected from defect, from separately, and at the same time, being held invalid or changed during reexamination. The overlap of the claims in the reissue application and the reexamination, therefore requires that “the patent owner will be required to place and **maintain the same claims in the reissue application and the ex parte reexamination** proceeding during the pendency of the merged proceeding.” 37 C.F.R. § 1.565(d). And any examiner actions and patent owner responses in the merged proceeding “will apply to both the reissue application and the ex parte reexamination proceeding and will be physically entered into both files.” *Id.* Were the reexamination and the reissue application not concurrent, as is the case here, then 37 C.F.R. § 1.565(d) would not be applicable to MPEP § 1449.01 and would not have been cited therein.

This framework, initially highlighted by MPEP § 1449.01 in regards to merged cases, equally applies when the reissue application and the reexamination were not merged. In providing examples of non-merger situations, MPEP § 1449.01 applies the same definition of concurrence as used for merger situations, i.e., that the **same claims** are under reissue and reexamination at the same time. See, e.g., MPEP § 1449.01(B) (stating “where a reissue application prosecution is stayed or suspended, and the prosecution of a reexamination proceeding for the patent **(for which reissue is requested)** is permitted to proceed” and “where a reissue application is filed after the reexamination proceeding has entered the publication process, such that it is **too late** to consider the question of stay or merger.”) (Emphasis added).

In contrast to MPEP § 1449.01, where concurrence is defined as occurring between a reexamination and a reissue application on the same patent, in the instant case the ‘102 Reexamination was filed over two years after the reissued patent RE37,585. Application Serial No. 09/366,685 issued on March 19, 2002 as RE37,585; while Reexamination Application 90/007,102 was not filed until over two (2) years later, on June 25, 2004. There is no concurrence regarding the RE37,585 patent, i.e., no concurrent reexamination of the same claims. The ‘102 Reexamination could not have been merged with the reissue application, because the latter had already completed before the filing of the former, leaving 37 C.F.R. § 1.565(d) unavailable. Nor could one have been stayed pending the other, for the same reason.

Simply put, concurrence as set forth in MPEP § 1449.01 does not apply to the instant application, because the instant application is not the application for which concurrence would have been required under MPEP § 1449.01; that application was the RE37,585 case. The present application is related to the RE37,585 in that they are both reissue applications of the original U.S. Patent No. 5,656,186; but the instant application is not a reissue of RE37,585. That is, the instant application is not seeking to correct errors in the RE37,585. Furthermore, the claims of the instant application are different than those of RE37,585, because the instant application is a divisional reissue application, filed during pendency of the RE37,585 reissue case, but with claims directed to a constructively elected, different inventive subject matter. In other words, the ‘102 Reexamination sought review of the claims in the RE37,585, but the ‘102 Reexamination did not involve review of the divisional claims in the instant application.

The mere fact that the instant application was pending at the time of the ‘102 Reexamination does not mean that MPEP § 1449.01 would have applied¹.

Indeed, neither the Patent Office nor the Applicant operated in a manner that suggested the current language of subsections (A) and (B) of MPEP § 1449.01 applied at the time.

At the time the reexamination request was granted (i.e., August 23, 2004), MPEP 1449.01 (Eighth Edition, Rev. 2, May 2004) instructed that when “a reissue application and a reexamination proceeding are pending concurrently on a patent, and an order granting

¹ This point is made with the recognition that MPEP 1449.01(A) and (B) did not even exist at the relevant time.

reexamination has been issued for the reexamination proceeding, the files for the reissue application and the reexamination will be forwarded to the Office of Patent Legal Administration (OPLA) for a decision whether to merge the reissue and the reexamination, or stay one of the two.” (Emphasis added). There is no indication that the OPLA was notified of the co-pendency between the instant application and the ‘102 Reexamination. There was no merger of the reexamination and the instant application, nor was there any indication that the OPLA stayed one in lieu of the other. Nor did the patent owner petition for merger or stay, although such petition was available under 37 C.F.R. § 1.182. In fact, at the time, there was no reason to believe that the instant application, containing different claims than those under reexamination, should have been merged or stayed. Had there been any indication from the Patent Office, either from the OPLA or the Examiner, that the claims in the divisional application would be estopped based on the claims in the reexamination application, then the patent owner could have, at that time, sought to merge both cases or stay the reexamination, thus avoiding the Examiner’s now-well-after-the-fact estoppel rejection.

C. The Claims of the Instant Application Could Not Have Been Added to the Reexamination Request, as Required by MPEP 1449.01(B).

MPEP § 1449.01(A) and (B) provide “guidance to address the situation where a reexamination certificate is to be issued for a patent, while a reissue application for the patent is pending and will not be merged with the reexamination.” As MPEP § 1449.01(B) instructs, its guidelines do not apply where (a) the broader claims in the reissue application can be patentable, while claims in the reexamination are not; and (b) where the broader claims in the reissue application could not have been presented in the reexamination proceeding. See, MPEP §§ 1449.01(B)(3)(a) and (b).

Taking the exceptions in order, Applicant notes that the claims in the instant reissue application are different from those of the RE37,585 F1, and may indeed be patentable irrespective of the patentability of the claims at issue therein. In fact, prior to the current Official Action, the claims of the instant application had been deemed patentable over the prior art. Therefore, the first prong of the exemption applies.

For the second prong, the claims in the instant application could not have been presented in the reexamination proceeding, unless the instant application were to have been merged with the reexamination proceeding, which it was not. The current claims were filed

by way of a divisional reissue application of the original U.S. Patent No. 5,656,186 and based off the reissue application that eventually resulted in RE37,585. The instant divisional application was filed on February 1, 2001, as was the co-pending divisional application U.S. Serial No. 09/775,106. The '102 Reexamination was filed based off of RE37,585 on March 19, 2002. Because RE37,585 had already issued by the time of the filing of the '102 Reexamination, there was no mechanism by which to present the claims of the instant divisional application in the reexamination.² The only mechanism would have been through merger, but MPEP § 1449.01(B) describes situations where no merger has occurred.

In any event, because the claims of the instant application could not have been presented in the reexamination proceeding absent merger, which did not occur, and because the current claims can be patentable irrespective of the reexamined claims, the guidelines of MPEP § 1449.01(B) do not apply. For this reason as well, the rejections are traversed.

There Has Been No Surrender of the Subject Matter of the Pending Claims.

The Court of Appeals for the Federal Circuit has set forth a three-step test for applying the recapture rule. *In re Clement*, 131 F.3d 1464, 1468-70 (Fed. Cir. 1997); *see, also* MPEP § 1412.02. The first step is to determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims – here that would mean the original claims in the reissue application that led to RE37,585. The second step is to determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution. The third step is to determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule. MPEP § 1412.02.

In concluding that the pending claims of the instant application go beyond the scope of the RE37,585 F1 reexamination, the Examiner points to the fact that the claims reference a “log-log” relationship between fluence threshold at which breakdown occurs, but not a relationship of fluence threshold at which breakdown occurs versus laser pulse width that exhibits a distinct change in slope as recited in various of the reexamined claims.

² It is noted that the current MPEP § 1449.01 does talk in terms of multiple reissue applications, although such language was not included in the versions of the MPEP that governed at the time of the '102 Reexamination. And either way, even with the current language, the discussion is in terms of the reexamination case being concurrent with at least the reissue application having the same claims. That is at the time of the '102 Reexamination, even though the instant application was pending, it was not pending with the RE37,585 reissue case.

The Examiner's analysis does not satisfy the second step of the recapture query, because neither the cited language missing from the claims nor the "log-log" language now added relate to subject matter surrendered as a result of the reexamination. The language pointed to by the Examiner is in the preamble of the respective claims, while the amendments during prosecution of the '102 Reexamination – to the extent they were made for patentability purposes – were in the body of the claims. The Examiner has established no connection with the claim language discussed in Para. 6 of the Official Action and that of any surrendered subject matter. The second step of the recapture query is not met. There has been no surrender regarding that subject matter.

D. Conclusion

In light of the foregoing, Applicant respectfully traverses the § 251 rejections of the Official Action; and, as such, Applicant has not re-written the claims based on the RE37,585 F1 reexamination certificated.

VI. Conclusion

In light of the foregoing, applicant respectfully asserts that claims 46-50, 52-54, 56-66, and 68-118 are in condition for immediate allowance. Confirmation of the same is respectfully requested.

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned at the indicated number.

Dated: July 13, 2012

Respectfully submitted,

By /Paul B. Stephens/

Paul B. Stephens

Registration No.: 47,970

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant